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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,406	04/19/2004	Thomas H. Watkins III	5418-102US	2591
Richard C. Woodbridge, Esq. Synnestvedt Lechner & Woodbridge, LLP P.O. Box 592 Princeton, NJ 08542-0592				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/827,406

Applicant(s)

WATKINS ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 have been examined. Application 10/827,406 (METHOD AND APPARATUS FOR DIGITALLY INTEGRATING SALES, CONFIRMATION AND BILLING OF PUBLISHED ADVERTISING) has a filing date 04/19/2004 and Claims Priority from Provisional Application 60464406, filed 04/18/2003.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. With respect to claims 1-9, Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus), as a website is software. With

respect to claims 10-20 are defined as system claims however, are claiming functional descriptive material (i.e. software) as a website is defined as software.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is indefinite because does not mention what entity the first user is paying an offered amount. For purpose of art rejection, said entity would be considered to be the second user. Claims 1-9 are indefinite because said claims do not have structure and claims 10-20 are not system claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talegon (US 2003/0135460) in view of Applicant's Background of the Invention and further in view of Chang (US 2003/0107640).

Claims 1, 10 and 19, Talegon teaches:

An printed publication, electronic transaction method, comprising the steps of: submitting, by a first user using a web-site, an offered amount for publishing one

or more print advertisements in one or more selected printed publications (see paragraphs 16-17);

processing, by a second user using said web-site, said offered amount (see paragraphs 16-17);

publishing, by said second user, said print advertisement in said printed publication (see paragraph 15);

paying, by said first user using said web-site, said offered amount (see paragraph 19).

Talegon does not teach placing, on said web site by said second user, a digital proof of publication of said publishing; viewing, by said first user, said digital proof of publication. However, Applicant's background of the Invention mentioned that it is old and well known in the promotion art to send to an advertiser an advertiser's bill with a tearsheet, where said tearsheet is an actual physical copy of the page on which said advertiser's advertisement appeared, taken from a copy of a publication where said advertisement was published (see paragraph 4). Chang teaches that it is old and well known in the computer art to convert a printed image into digital image by scanning said printed image into a computer using a computer's scanner (see paragraph 33) and also Chang teaches adding fiducial marks to said scanned digital image in order to correct printing errors on said scanned image (see paragraph 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Talegon would send to an advertiser an electronic bill with a digital tearsheet, as a digital proof of publication of an advertisement, as Applicant's

background of the invention teaches that it is old and well known in the promotion art to send to advertisers a bill with a printed tearsheet, as a printed proof of publication of an advertisement and Chang teaches that it is old and well known to convert a printed image into a digital image and adding fiducial marks to said digital image in order to correct printing errors in said digital image.

Claims 2 and 11, Talegon teaches:

submitting an offered amount further comprises the steps of:
selecting, by said first user, said selected printed publications (see paragraph 15);

creating an offer using an insertion request form, one or more standard rates, one or more offered rates submitted by said first user, different from said one or more standard rates and one or more run times, said offer including said offered amount and a digital form of said one or more print advertisements (see paragraph 16); and

submitting said offer (see paragraph 16).

Claims 3 and 12, Talegon teaches:

wherein said step of selecting further comprises the steps of:

generating a list of suitable printed publications based on a criteria chosen, by said first user, from the group consisting of an advertising type, a classification, a format, a publication frequency and a readership demographic, or a combination thereof (see paragraph 15); and

selecting, by said first user, said selected printed publications from said list of suitable publications (see paragraph 15).

Claims 4 and 13, Talegon teaches:

wherein said step of processing further includes the step of negotiating, using said web-site, said negotiation comprising submitting one or more counter-offer rates different from both said offered rates and said standard rates (see paragraph 16).

Claims 5 and 14, Talegon teaches:

wherein said step of processing further includes the step of generating a run sheet, said run sheet comprising a list of dates of on which to publish said print advertisement in said printed publication (see paragraph 15).

Claims 6, 15 and 20, Talegon does not teach:

wherein said placing a digital proof of publication of said publishing, further comprises the steps of:

creating a paper tearsheet, said paper tearsheet comprising said published print advertisement on a printed page of said printed publication; placing said paper tearsheet on a fiducial underlay, said fiducial underlay comprising scale indicia indicative of an absolute size of said tearsheet; and creating a digital image of said paper tearsheet on said fiducial underlay. However, Applicant's background of the Invention mentioned that it is old and well known in the promotion art to send to an advertiser an advertiser's bill with a tearsheet, where said tearsheet is an actual physical copy of the page on which said advertiser's advertisement appeared, taken from a copy of a publication where said advertisement was published (see paragraph 4). Chang teaches that it is old and well known in the computer art to convert a printed image into digital image by scanning said printed

image into a computer using a computer's scanner (see paragraph 33) and also Chang teaches adding fiducial marks to said scanned digital image in order to correct printing errors on said scanned image (see paragraph 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Talegon would send to an advertiser an electronic bill with a digital tearsheet, as a digital proof of publication of an advertisement, as Applicant's background of the invention teaches that it is old and well known in the promotion art to send to advertisers a bill with a printed tearsheet, as a printed proof of publication of an advertisement and Chang teaches that it is old and well known to convert a printed image into a digital image and adding fiducial marks to said digital image in order to correct printing errors in said digital image.

Claims 7 and 16, Talegon does not teach:

wherein said fiducial underlay further includes resolution indicia indicative of an absolute resolution of said tearsheet, said resolution indicia comprising one or more alpha-numeric characters having a font size and a font type representative of text in said printed advertisement. However, Applicant's background of the invention mentioned that it is old and well known in the promotion art to send to an advertiser an advertiser's bill with a tearsheet, where said tearsheet is an actual physical copy of the page on which said advertiser's advertisement appeared, taken from a copy of a publication where said advertisement was published (see paragraph 4). Chang teaches that it is old and well known in the computer art to convert a printed image into digital image by scanning said printed image into a computer using

a computer's scanner (see paragraph 33) and also Chang teaches adding fiducial marks to said scanned digital image in order to correct printing errors on said scanned image (see paragraph 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Talegon would send to an advertiser an electronic bill with a digital tearsheet, as a digital proof of publication of an advertisement, as Applicant's background of the invention teaches that it is old and well known in the promotion art to send to advertisers a bill with a printed tearsheet, as a printed proof of publication of an advertisement and Chang teaches that it is old and well known to convert a printed image into a digital image and adding fiducial marks to said digital image in order to correct printing errors in said digital image.

Claims 8 and 17, Talegon does not teach:

wherein said fiducial underlay further includes color indicia indicative of an absolute color of said tearsheet, said color indicia comprising an image containing one or more colors representative of said printed advertisement. However, Applicant's background of the invention mentioned that it is old and well known in the promotion art to send to an advertiser an advertiser's bill with a tearsheet, where said tearsheet is an actual physical copy of the page on which said advertiser's advertisement appeared, taken from a copy of a publication where said advertisement was published (see paragraph 4). Chang teaches that it is old and well known in the computer art to convert a printed image into digital image by scanning said printed image into a computer using a computer's scanner (see paragraph 33) and also Chang teaches adding fiducial

marks to said scanned digital image in order to correct printing errors on said scanned image (see paragraph 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Talegon would send to an advertiser an electronic bill with a digital tearsheet, as a digital proof of publication of an advertisement, as Applicant's background of the invention teaches that it is old and well known in the promotion art to send to advertisers a bill with a printed tearsheet, as a printed proof of publication of an advertisement and Chang teaches that it is old and well known to convert a printed image into a digital image and adding fiducial marks to said digital image in order to correct printing errors in said digital image.

Claims 9 and 18, Talegon teaches:

wherein said paying said offered amount includes automatically making a first electronic payment to said second user, and automatically making a second electronic payment to a provider of said electronic transaction method (see paragraph 19).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
September 19, 2008